



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS MN 55402-0903

COPY MAILED

OCT 25 2007

OFFICE OF PETITIONS

In re Application of :
Tnompson et al : DECISION DISMISSING
Appl. No. 10/810,547 : PETITION UNDER
Filed: March 26, 2004 : 37 CFR 1.183
:

This is a decision on the May 30, 2007 renewed petition filed under 37 CFR 1.47, which is taken as a petition under 37 CFR 1.183¹ requesting suspension or waiver of the regulations (presumably 37 CFR 1.172) that require the named inventors to sign any supplemental declaration in a broadening reissue application.

The petition is dismissed as moot.

BACKGROUND

1. U.S. Patent No. 6,363,200 (the '200 patent) issued to Thompson, Johnson and Tischler on March 26, 2002.
2. A broadening reissue application (the present application) was filed for the '200 patent on March 26, 2004, and it was assigned application number 10/810,547.
3. A petition filed under 37 CFR 1.47 was granted on November 17, 2004. Rule 47 status was granted for non-signing inventor Johnson.
4. During the prosecution of the application, the Office required a supplemental reissue declaration directed to errors in the original patent which were corrected in the application after the signing of the original reissue

¹ Once an application has received a properly executed oath or declaration and such has been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603. In addition, if a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor. See MPEP 1414.01

declaration.

5. On May 29, 2007, applicant filed the present petition under 37 CFR 1.47, which is being taken as a petition under 37 CFR 1.183 requesting suspension or waiver of the "regulations pertaining to the filing of a Supplemental Declaration under 37 C.F.R. § 1.175" that require a supplemental reissue declaration to be signed by the inventors.
5. The petition is accompanied by a Supplemental Reissue Application Declaration by inventors Thompson and Tischler signed May 2007. It is for this supplemental declaration that the petition requests acceptance, via suspension or waiver of the regulations.

DECISION

The provisions of 35 U.S.C. 251, which are directed to reissue of patents, do not address the signature requirements of a declaration or oath in reissue. As to the reissue regulations, 37 CFR 1.172 requires that a reissue declaration or oath be made (and signed) by the inventors, except as otherwise provided (37 CFR §§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. In addition, 37 CFR 1.175(b)(1), requires that:

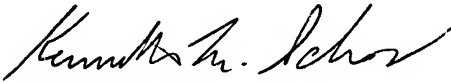
"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a **supplemental oath or declaration** stating that every such error arose without any deceptive intention on the part of the applicant."
[Emphasis added]

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires that a supplemental oath or declaration be signed by the inventor(s). This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999) (reported, but unpublished). Thus, each oath and/or declaration must bear the appropriate signatures of the inventors.

In the present instance, the supplemental declaration is not signed by the one inventor who failed to execute the original reissue declaration (i.e., inventor Johnson). Since this application was previously granted Rule 47 status pursuant to 37 CFR 1.47, Petitioner is not required to obtain the signature of Johnson on the supplemental reissue declaration. Accordingly, the petition is moot, and is dismissed as such.

Jurisdiction over this application is being forwarded to Art Unit 2872 for review of the supplemental declaration submitted with the petition.²

Please direct any questions related to this decision to Petitions Attorney Charlema R. Grant, at (571) 272-3215.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Petitions

²This decision takes no position on the propriety of the supplemental declaration, aside from the signing of the named inventors. Any issues raised by the declaration will be addressed by the examiner in the next Office action.